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BARNES & THORNBURG LLP P.O. Box 2786 CHICAGO, IL 60690-2786			BOYCE, ANDRE D	
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/740,201

Filing Date: December 18, 2000

Appellant(s): O'MEARA ET AL.

William M. Lee, Jr.
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 8/11/11 appealing from the Office action
mailed 10/14/10.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:
Claims 1-29, 35 and 36 are pending, while claims 1-23 and 35 are rejected.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

None

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-23 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Based upon consideration of all of the relevant factors with respect to the claim as a whole, claim(s) 1-23 are held to claim an abstract idea, and is/are therefore rejected as ineligible subject matter under 35 U.S.C. 101 *Bilski v. Kappos*, 95 USPQ2d 1001 (U.S. 2010). The rationale for this finding is explained below:

In order for a method to be considered a "process" under §101, a claimed process must either: (1) be tied to a particular machine or apparatus, or (2) transform a particular article to a different state or thing.

With respect to independent claims 1 and 23, the claim language recites the steps of maintaining a current order, maintaining a prioritized listing, receiving said location-based order, updating said current order, etc. Here, there is insufficient recitation of a machine or transformation, and/or wherein involvement of machine, or transformation with the steps is merely nominally, insignificantly, or tangentially related to the performance of the steps, e.g., data gathering, or merely recites a field in which the method is intended to be applied.

In addition to the discussion in the BPAI decision filed 11/6/09, on pages 16-17, not included here for brevity, but still applicable, the recitation "said method being carried out by an ordering server programmed to carry out the steps of the method," has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of

the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Claims 2-22 are rejected based upon the same rationale, wherein the claim language does not include the required tie or transformation.

Claim 35 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 35 recites "[a] computer program product comprising a physical data carrier in machine readable form..." The broadest reasonable interpretation of a claim drawn to a computer program product typically covers forms of non-transitory tangible media and transitory propagating signals per se in view of the ordinary and customary meaning of computer readable media, particularly when the specification is silent (as is Appellant's specification), or open-ended. Moreover, the term "physical," which does not appear in Appellant's specification, may be defined as "of or relating to natural science or physics" (Merriam-Webster's Collegiate Dictionary, Tenth Edition, 1999). As such, the claim is rejected as covering a signal per se, which is not directed towards statutory subject matter. See MPEP 2111.01.

(10) Response to Argument

In the Appeal Brief, Appellant argues that 1) the claimed invention satisfies both the "machine" and "transformation" branches of the test, and the rejection was improperly based solely on the "machine or transformation" test, 2) the Examiner erred in refusing to accord patentable weight to the preamble, and it is submitted that this holding was incorrect as a matter of law, and 3) it appears from the Notice of Panel Decision from Pre-Appeal Brief of April 12, 2011 that the rejection of claim 35 is no longer upheld, and that the only issue with claim 35 in the Final Office Action concerned the question of whether this claim covered transitory signals. By amendment filed on December 9, 2010, Appellants sought to amend claim 35 by reciting that the computer program product comprises a "non-transitory computer-readable medium". This amendment was not entered but was simultaneously indicated to be regarded as sufficient to overcome the rejection of claim 35 (see Advisory Action dated January 20, 2011).

With respect to argument 1, the Examiner respectfully disagrees. While the machine and transformation test is no longer the sole basis for determining 101 method eligibility, it remains an investigative tool and one of the factors used in determining 101 method eligibility.

As a result, and based upon consideration of all of the relevant factors with respect to the claim as a whole, claim(s) 1-23 are held to claim an abstract idea, and is/are therefore rejected as ineligible subject matter under 35 U.S.C. 101 *Bilski v.*

Kappos, 95 USPQ2d 1001 (U.S. 2010). The rationale for this finding is explained below:

One of the decisive factors weighing against patent-eligibility is no or insufficient recitation of a machine or transformation.

With respect to independent claims 1 and 23, the claim language recites the steps of maintaining a current order, maintaining a prioritized listing, receiving said location-based order, updating said current order, etc. Here, there is insufficient recitation of a machine or transformation, and/or wherein involvement of machine, or transformation with the steps is merely nominally, insignificantly, or tangentially related to the performance of the steps, e.g., data gathering, or merely recites a field in which the method is intended to be applied. Moreover, the claim steps recite a mere statement of a general concept, wherein the steps could be performed without any apparatus.

With respect to argument 2, the Examiner respectfully disagrees. The recitations “computer-implemented method” and “said method being carried out by an ordering server programmed to carry out the steps of the method, which comprise” has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535

F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Specifically it is not clear which of the recited method steps, if any, would explicitly require the ordering server. Moreover, the method claim includes the language "steps of the method, which comprise." As discussed in the MPEP 2111.03:

The transitional term "comprising", which is synonymous with "including," "containing," or "characterized by," is inclusive or open-ended and does not exclude additional, unrecited elements or method steps. See, e.g., *> Mars Inc. v. H.J. Heinz Co.*, 377 F.3d 1369, 1376, 71 USPQ2d 1837, 1843 (Fed. Cir. 2004) ("like the term comprising,' the terms containing' and mixture' are open-ended."); *< Invitrogen Corp. v. Biocrest Mfg., L.P.*, 327 F.3d 1364, 1368, 66 USPQ2d 1631, 1634 (Fed. Cir. 2003) ("The transition comprising' in a method claim indicates that the claim is open-ended and allows for additional steps."); *Genentech, Inc. v. Chiron Corp.*, 112 F.3d 495, 501, 42 USPQ2d 1608, 1613 (Fed. Cir. 1997) ("Comprising" is a term of art used in claim language which means that the named elements are essential, but other elements may be added and still form a construct within the scope of the claim.); *Moleculon Research Corp. v. CBS, Inc.*, 793 F.2d 1261, 229 USPQ 805 (Fed. Cir. 1986); *In re Baxter*, 656 F.2d 679, 686, 210 USPQ 795, 803 (CCPA 1981); *Ex parte Davis*, 80 USPQ 448, 450 (Bd. App. 1948) ("comprising" leaves "the claim open for the inclusion of unspecified ingredients even in major amounts").

As a result, the ordering server may simply carry out steps not explicitly recited in the method claim, or steps deemed to be nominally, insignificantly, or tangentially related to the performance of the invention.

With respect to argument 3, the Examiner submits that claim 35 remains rejected, as discussed in Final office action filed 10/14/10, reproduced above. In addition, the Notice of Panel Decision from Pre-Appeal Brief Review, filed 4/12/11, inadvertently omitted claim 35 as being rejected. Lastly, as discussed in the Advisory Action filed 1/20/11, the proposed amendment filed by Appellant on 12/9/10

would have been sufficient to overcome the rejection to claim 35, however the amendment was not entered, as detailed in the Advisory Action. As a result, claim 35 remains rejected.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Andre Boyce/

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